

REMARKS

The applicant thanks the Examiner for the thorough examination of the application. The amendment to the specification corrects a minor typographical error. No new matter is believed to be added to the application by this amendment.

Status of the Claims

Claims 1-12 are pending in the application. Claims 1-8 stand rejected. Claims 9-12 are new and find support at page 10 of the specification.

Rejection Under 35 U.S.C. §103(a) Over Oka

Claims 1-8 are rejected under 35 U.S.C. §103(a) over Oka (U.S. Patent 5,292,132). Applicant traverses this rejection and respectfully requests reconsideration and withdrawal thereof.

The Present Invention and its Advantages

The present invention pertains to a novel golf ball having 360 dimples arranged so that there is only one great circle zone not intersecting with the dimples. The dimples occupy 70% or more of the golf ball's surface.

An important aspect of the invention lies in that two or more rectangles having a 1.0 mm X 2.4 mm size can be formed in an area not lying in any of the dimples, and 16 to 60 of these configurations can be found in a region not proximate to the great

circle zone. These rectangles do not separate from each other and also do not overlap by more than half the entire area of each.

The configuration of the inventive golf ball has the goal of making many large flat portions not containing any dimples. That is, the flat portions are increased in comparison with golf balls of the conventional art. The result of the novel dimple configuration is an attractive looking golf ball that has superior flight distance.

Distinctions of the Invention Over Oka

Oka pertains to a golf ball having dimples and lands, where the dimples are arranged so that less than 40 lands are provided which contain a rectangle having a short side greater than 0.4 mm and an area greater than 0.8 mm² and not including a part of the dimple or the whole thereof. See Abstract of Oka. Oka at column 1, lines 42-45 states: "It is an essential object of the present invention to provide a golf ball having a long flight distance by making the area of lands smaller and arranging complex dimples densely on the surface thereof."

Oka fails to disclose or suggest a golf ball that maximizes the flat portions.

Oka pertains to small flat portions, and the largest (land 2-a in Table 3) has dimensions of 1.1 mm short side and an area of 2.9 mm². However, there are only 2 of these largest flat portions, as is discussed at columns 7, lines 40-43. In contrast, the present

invention has 16-60 of these large areas, as is set forth in independent claim 1. As a result, the teachings of Oka would fail to motivate a person having ordinary skill in the art to produce a claimed embodiment of the invention with the 16-60 flat area limitation.

Further, Oka is directed at optimizing the area covered by dimples, as discussed at column 1, lines 42-45, quoted above. However, please note the disclosure at page 10 of the specification, which sets upper limits to the area covered by dimples. See also new claims 9-12. As a result, Oka teaches away from the present invention.

In the Office Action, the Examiner turns to Figure 7 to infer that the rectangles do not overlap by more than 50% of their area. However, the largest flat portion of Oka, discussed above, would overlap by more than 50%.

Further, when discussing the rectangles, the Examiner states: "It would be apparent that the total area of the lands having two or more rectangles would be satisfied from the above conditions which would satisfy the conditions in any shaped configuration of that of the present invention." By this, the Examiner is inferring that the claimed invention is inherent in Oka.

Recently, the Federal Circuit stated in In re Robertson, that "to establish inherency, extrinsic evidence must make clear that the missing descriptive matter was necessarily present in the thing

described in the reference, and would be so recognized by persons with ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a set of circumstances is not sufficient." In re Robertson, 49 USPQ2d 1949 (Fed. Cir. 1999). Further, it has been held that the mere fact that a certain thing may result from a given set of circumstances is not sufficient, and occasional results are not inherent. MEHL/Biophile International v. Milgraum, 52 USPQ2d 1303 (Fed. Cir. 1999).

Although the Examiner has inferred that the rectangle overlap area would be apparent to one of ordinary skill, the Examiner has failed to produce evidence as to why this purported inherency would be evident to one of ordinary skill.

Yet further, the Examiner relies upon the one Oka reference. However, Oka fails to set forth or suggest each and every element of independent claim 1.

To establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP §2142. In addition, if a reference needs to be modified to achieve the claimed invention "there must be a showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the obviousness conclusion." Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp., 55 USPQ2d 1927 (Fed. Cir. 2000).

Accordingly, the burden is on the Examiner to produce a suggestion or motivation to modify the teachings of Oka to produce a claimed embodiment of the invention.

As has been shown, the teachings of Oka would fail to motivate a person having ordinary skill in the art to produce the invention as embodied in independent claim 1. Thus, a *prima facie* case of obviousness has not been made. Claims dependent upon claim 1 are patentable for at least the above reasons alone.

Further, even if it assumed *arguendo* that a *prima facie* case of obviousness can be made over Oka, this purported obviousness is rebutted by unexpected results.

Table 1 at page 28 of the specification gives results for inventive and comparative golf balls. The inventive golf balls have a number of large flat portions in the 16-60 range. The comparative golf balls have a number of large flat portions outside of the 16-60 range. The inventive golf ball show appreciably superior flight distance. As a result, the advantages of the inventive golf ball is clear.

As has been shown, Oka fails to render the invention *prima facie* obvious. Also, unexpected results rebut any obviousness that

can be alleged. Accordingly, this rejection is overcome and withdrawal thereof is indicated.

Information Disclosure Statement

Applicant thanks the Examiner for considering the Information Disclosure Statement filed November 8, 2000 and for making the initialed PTO-1449 form of record in the application in the Office Action mailed February 8, 2002.

Conclusion

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E. Goozner, Ph.D., (Reg. No. 42,593) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any


overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By

 #39,538 ✓
Joseph A. Kolasch, #22,463


JAK/REG
2927-0117P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachment: Version with Markings to Show Changes Made

(Rev. 02/20/02)

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

The paragraph beginning on page 24, line 16, has been amended as follows:

[EXAPLES] EXAMPLES

The effect of the present invention will be described by experiments conducted based on the examples. Needless to say, the present invention should not be restrictively interpreted based on the description of the examples.

IN THE CLAIMS:

Claims 9-12 are new.